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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/732,348	12/07/2000	Yen Choo	8325-2012	1675

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EXAMINER

COLLINS, CYNTHIA E

ART UNIT PAPER NUMBER

1638

DATE MAILED: 12/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/732,348

**Applicant(s)**

CHOO ET AL.

**Examiner**

Cynthia Collins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 May 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 24-70 is/are pending in the application.
- 4a) Of the above claim(s) 43 and 51-70 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 24-42 and 44-50 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Supplemental Election/Restrictions***

In the amendment filed January 17, 2003, claims 1-23 were cancelled. Claims 24-70 were newly added.

In the amendment filed June 24, 2003, claims 26, 27, 29, 53, 54 and 56 were amended.

In the amendment filed May 26, 2004, claims 25 and 52 were amended.

In the reply filed August 16, 2002, Applicant elected with traverse Group III, claims 15 and 22, and linking claims 7-8, 10-14 and 17-21, directed to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional activator domain.

Newly submitted claims 43 and 51-70 are directed to an invention that is independent or distinct from the invention originally elected for the following reasons: newly submitted claims 43 and 51-70 are directed to the inventions of Groups I, II and IV (a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional activator domain, a method of regulating transcription comprising introducing into a plant cell an engineered zinc finger polypeptide fused to a transcriptional repressor domain, and a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional repressor domain). Since applicant has received an action on the merits for the originally elected invention, claims 43 and 51-70 are withdrawn from consideration as being directed to a non-elected invention.

With respect to newly submitted claims 24-42 and 44-50, restriction to one of the following inventions is required under 35 U.S.C. 121:

- A. Claims 24-29, 32-42 and 44-50, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide fused to a transcriptional activator domain, classified in class 435, subclass 419, for example.
- B. Claims 24 and 30-31, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide, wherein one or more of the zinc fingers of the polypeptide comprises a mutated model zinc finger domain of a zinc finger from a Zif268 protein, classified in class 435, subclass 419, for example.
- C. Claims 24 and 30-31, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide wherein one or more of the zinc fingers of the polypeptide comprises a mutated model zinc finger domain of a zinc finger from a GLI protein, classified in class 435, subclass 419, for example.
- D. Claims 24 and 30-31, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide wherein one or more of the zinc fingers of the polypeptide comprises a mutated model zinc finger domain of a zinc finger from a Tramtrack protein, classified in class 435, subclass 419, for example.
- E. Claims 24 and 30-31, drawn to a plant host cell and transgenic plant comprising a polynucleotide encoding an engineered zinc finger polypeptide wherein one or more of the zinc fingers of the polypeptide comprises a mutated model zinc finger

domain of a zinc finger from a YY1 protein, classified in class 435, subclass 419, for example.

Claim 24 link(s) inventions A-E. Claim 30 link(s) inventions B-E. The restriction requirement among the linked inventions is subject to the nonallowance of the linking claim(s), claims 24 and 30. Upon the allowance of the linking claim(s), the restriction requirement as to the linked inventions shall be withdrawn and any claim(s) depending from or otherwise including all the limitations of the allowable linking claim(s) will be entitled to examination in the instant application. Applicant(s) are advised that if any such claim(s) depending from or including all the limitations of the allowable linking claim(s) is/are presented in a continuation or divisional application, the claims of the continuation or divisional application may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Where a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. *In re Ziegler*, 44 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

The inventions are distinct, each from the other because of the following reasons:

The inventions of Groups B-E require a separate area of search directed to one or more of the zinc fingers of an engineered zinc finger polypeptide comprising a mutated model zinc finger domain, which search is not required for the invention of Group A. Further, each of inventions of Groups B-E requires an additional separate area of search directed to specific mutated model zinc finger domain corresponding to a distinct type of zinc finger protein (Zif268, GLI,

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Tramtrack and YY1) that originates from one of several different species of organisms (human, mouse, *Drosophila*).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by the requirement for different areas of search, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### ***Remarks***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cynthia Collins whose telephone number is (571) 272-0794. The examiner can normally be reached on Monday-Friday 8:45 AM -5:15 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson can be reached on (571) 272-0804. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cynthia Collins  
Examiner  
Art Unit 1638

CC

*Cynthia Collins* 12/27/04